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09/857,958	06/12/2001	Peter Maurits Maria Van Geert	CM1976	2560

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

mk-5

Office Action Summary

Application No.

09/857,958

Applicant(s)

VAN GEERT ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_ .
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Objections***

**Claims 12, 15, and 16** are objected to because of the following informalities: In claim 13, the term “thermoplatic” should be amended to “thermoplastic.” In claims 15 and 16, the term “wrheby” should be amended to “whereby.” In claim 16, Applicant should cancel one of the terms “the” or “said” from the phrase “whereby the said embossed layer...” Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 11-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11-12, it is not clear what part of the embossed layer is “organic solvent based” since claim 12 shows that the embossed layer comprises a lacquer and a thermoplastic film. For purposes of examination, it will be understood that the lacquer comprises an organic solvent.

In claim 11, it is not clear whether the phrases “organic solvent based” or “water solvent based” means that the layers *comprise* these solvents or that they are *soluble* in these solvents.

In claim 11, the phrase “located onto” is unclear.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 11-13 and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Coburn, Jr., U.S. Pat. No. 4,999,075 in view of Kay et al., U.S. Pat. No. 5,319,475 and in further view of Verma, U.S. Pat. No. 4,116,904.

Coburn shows a security card laminate comprising an embossed polyester thermoplastic plastic film (column 4, lines 37-57) with a first layer of indicia, a metal layer, a background ink layer (primer), a second layer of indicia, and a clear plastic film (claim 1).

Coburn does not show that the embossed layer is organic solvent-based as in instant claim 11. Coburn does not show that the printing ink layer is organic solvent-based as in instant claim 11. Coburn does not show that the first layer of indicia comprises a lacquer and thermoplastic film as in instant claim 12. Kay shows a tamper resisting holographic security seal comprising a solvent soluble embossed lacquer layer 3 (indicia and ink layer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a solvent-soluble or solvent-based embossable indicia/lacquer layer so that such solvents used to tamper with the security card would deteriorate and show any tampering of the card. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use lacquer in the first layer of indicia because it is known that lacquer is effectively used to print images and indicia in security cards.

Coburn does not show that the background ink layer (primer) is water solvent-based as in instant claim 11 nor that it comprises acrylic compounds as in instant claim 18. Verma shows a water-based primer comprising acrylic compounds and pigments which are applied to a variety

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of substrates such as metal, painted metal, or acrylic lacquer (column 3, line 1 to column 4, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a water-based primer comprising acrylic compounds and pigments as the background ink layer in Coburn because it is known that such a composition provides excellent adhesion to the metal layer and that the pigments provide good corrosion resistance.

Claim 12 is rejected because they are product-by-process claims. Additionally, the phrase "embossed layer is formed from a laquer applied to a thermoplastic film" in claim 12 introduces process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

**Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coburn, Jr., U.S. Pat. No. 4,999,075 in further in view of Kay et al., U.S. Pat. No. 5,319,475 and in further view of Verma, U.S. Pat. No. 4,116,904.

Coburn, Verma, and Kay are relied upon as above for claim 11. Coburn further shows laminating a clear plastic film to the polyester thermoplastic film (claim 1). Coburn does not show that the clear plastic film is thermoplastic as in instant claim 14. Kay shows a clear carrier thermoplastic layer is used in the tamper resistant security seal (claim 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermoplastic material in the clear plastic film of Coburn because it is known that thermoplastics

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are effectively used in security cards because they can be transparent and are mechanically strong due to their insusceptibility to solvent attack.

Claim 14 is rejected because they are product-by-process claims. Additionally, the phrase "film is laminated to another..." in claim 14 introduces process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP* 2113. Further, process limitations are given no patentable weight in product claims.

**Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coburn, Jr., U.S. Pat. No. 4,999,075 in view of Kay et al., U.S. Pat. No. 5,319,475.

Coburn and Kay are relied upon as above for claim 11. Coburn does not show that the metal layer comprises aluminum as in instant claim 15. Kay shows a tamper resistant security seal comprising an aluminum metal layer laminated to an embossed lacquer (column 4, lines 25-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use aluminum in the metal layer of Coburn since aluminum is well known in the art as an effective metal for use in security documents because tampering with the aluminum layer will show as the aluminum loses its reflectance.

**Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coburn, Jr., U.S. Pat. No. 4,999,075 in view of Kay et al., U.S. Pat. No. 5,319,475 and in further view of Verma, U.S. Pat. No. 4,116,904.

Coburn, Verma, and Kay are relied upon as above for claim 11. Coburn does not show that the embossed layer comprises an acrylic-based lacquer as in instant claim 16. Kay shows a

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tamper resisting holographic security seal comprising an embossed lacquer layer 3 comprising vinyl-acrylic (column 3, lines 58-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an acrylic-based lacquer as the embossed layer of Coburn since it is known that such a layer, when modified and embossed, generates optically variable effects as well as providing a color or tint to the security document.

**Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coburn, Jr., U.S. Pat. No. 4,999,075 in view of Kay et al., U.S. Pat. No. 5,319,475 and in further view of Verma, U.S. Pat. No. 4,116,904.

Coburn, Verma, and Kay are relied upon as above for claim 11. Coburn does not show that the second ink layer comprises a colored and white ink wherein the colored ink comprises an ethanol solvent and the white ink comprises an ethylacetate solvent as in instant claim 17.

Verma shows a water-based colored composition comprising acrylic compounds and pigments which are applied to a variety of substrates such as acrylic lacquer (column 3, line 1 to column 4, line 30). Verma further shows that the composition can comprise white and colored pigments with ethanol and ethylacetate solvents (column 1, line 51 to column 2, line 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use colored and white inks with the instantly claimed solvents because it is known that such a composition provides excellent adhesion to the acrylic lacquer or enamel substrates and that the pigments provide good corrosion resistance.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen  
Examiner  
September 20, 2002

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